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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,226	06/01/2001	Darrel D. Cherry	10008157-1	6963

7590 07/03/2006

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,226	CHERRY ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/1/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 11, this claim recites the limitation "said prompting". There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 22, this claim recites the limitation "providing an advertising provider". it is unclear as to how an advertising provider can be provided.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kent (U.S. Pub No. 2002/0040374).** Kent teaches a method and system of creating personalized publications that includes all of the limitations recited in the above claims.

Regarding claims 1-3 and 6-8, Kent teaches storing advertisements (Paragraph 0079, Sentence 1) and media selections (Paragraph 0058, Sentence 1), communicating with a remote device (Paragraph 0083, Sentence 1), printing hardcopy media products (Paragraph 0083, Sentence 1), retrieving information from a user (Paragraph 0038, Sentence 1), and displaying lists of available media selections (Paragraph 0038, Last Sentence). Media publisher computers and advertisement providers are inherent in the system.

3. **Claims 10, 16-18, 22, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle (U.S. Pub No. 2002/0077891).** Castle teaches a method and system of creating personalized publications that includes all of the limitations recited in the above claims.

Regarding claims 10 and 18, Castle teaches inputting user personal information (Paragraph 0015, Sentence 2), obtaining a media request from a user (subscribing is a request) (Paragraph 0010, Sentence 1), querying at least one advertising provider for an advertisement and receiving the advertisement in electronic form (Paragraph 0029, Sentence 1), and merging the media and the advertisement for the user (Paragraph 0027).

Regarding claim 16, Castle teaches receiving bids for advertisements (Paragraph 0029), comparing the bids (abstract), selecting a winning bid (highest-paying) (abstract), and informing the advertising provider of the winning bid (inherently informed when a bill is sent).

Regarding claim 17, Castle teaches the advertising provider as specifying the size or location of the advertisement within the publication (Paragraph 0016, Last sentence).

Regarding claims 22 and 24, Castle teaches receiving advertisement information and user information from a media creation service (providing assurance) (Paragraph 0014, Sentence 1), determining and submitting a bid for an advertisement and submitting the advertisement in electronic form (Paragraph 0029). User demographic information includes income, interests, profession, and user preferences (Paragraph 0015, Sentence 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kent (U.S. Pub No. 2002/0040374) in view of Castle (U.S. Pub No. 2002/0077891).**

Regarding claim 4, Kent teaches a user profile database (Paragraph 0031, Sentence 1), a media database (Paragraph 0058, Sentence 1), and an advertisement database ((Paragraph 0012). Kent doesn't specify the advertisement data is also having corresponding bid amounts. Castle teaches a personalized publication system and method that takes bid amounts into consideration and stores them with advertisements (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to auction advertisements in personalized publications. "In this way advertising is sold at at least a "market" rate..." (Paragraph 0026, Last sentence).

Regarding claim 5, Castle teaches that user demographic information includes income, interests, profession, and user preferences (Paragraph 0015, Sentence 4).

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kent (U.S. Pub No. 2002/0040374).

Regarding claim 9, Kent teaches a user a registering (subscribing) with a publication (Abstract). Kent doesn't specify that a user needs to log in or is assigned a password to authenticate. Official notice is taken that it is old and well known to be assigned and input log-in identification when giving personal preference information online. Authentication is used by Amazon.com (as well as numerous other online retail sites and publication sites) to store wish lists and user preference information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to assign an identifier to a subscriber and use authentication methods to verify

said subscriber. This would allow subscribers to change preference information when needed.

6. Claims 19-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castle (U.S. Pub No. 2002/0077891).

Regarding claims 11-13, Castle teaches a user a registering (subscribing) with a publication (Abstract). Castle doesn't specify that a user needs to log in or is assigned a password to authenticate. Official notice is taken that it is old and well known to be assigned and input log-in identification when giving personal preference information online. Authentication is used by Amazon.com (as well as numerous other online retail sites and publication sites) to store wish lists and user preference information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to assign an identifier to a subscriber and use authentication methods to verify said subscriber. This would allow subscribers to change preference information when needed.

Regarding claims 19 and 23, Castle teaches receiving advertisement information from a media creation service (providing assurance) (Paragraph 0014, Sentence 1) and sending an advertisement and bid in electronic form (Paragraph 0029). Castle also teaches the price an advertiser is willing to pay as varying based on size of the advertisement, location of the advertisement (Paragraph 0012), or number of times in which the advertisement is printed (Paragraph 0029, Sentence 2). Castle does not specify the advertisement information as including the factors that affect the price of the

Art Unit: 3622

advertisements. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the media service to give an advertiser an idea of what advertising space is available should a publication opportunity arise before a bid is placed. This would give the advertisement provider a better opportunity at having his advertisement published (knowing what dimensions and location preferences would be optimal).

Regarding claim 20, Castle teaches that the advertisement provider is assured that the advertisement will be matched to demographics of subscribers (Paragraph 0014, Sentence 1). This will inherently aid in determining a value for the advertisement.

Regarding claims 14 and 21, Castle teaches that user demographic information includes income, interests, profession, and user preferences (Paragraph 0015, Sentence 4).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to targeted advertisements in publications and bidding systems:

U.S. Pub No. 2002/0046089 to Zorn

U.S. Pub No. 2002/0087594 to Peters

U.S. Patent No. 6,324,519 to Eldering

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER